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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/078,090	02/14/2002	Susana Salceda	DEX-0312	5706
26259	7590	01/28/2004	EXAMINER	
LICATLA & TYRRELL P.C.			BORIN, MICHAEL L	
66 E. MAIN STREET			ART UNIT	
MARLTON, NJ 08053			PAPER NUMBER	

1631

DATE MAILED: 01/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/078,090

Applicant(s)

SALCEDA ET AL.

Examiner

Michael Borin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-17 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

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### **Part III - DETAILED ACTION**

Claims 1-17 are currently pending.

#### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-5,7-9, drawn to isolated nucleic acid, expression vectors, cells comprising the vector, and method of producing a polypeptide classified in class 536, subclass 23.1 and class 935, subclass 66.
- II. Claim 6, drawn to method of use of product of Group I for detecting polynucleotides, classified in class 435, subclass 6.
- III. Claims 10,11, drawn to a purified polypeptide encoded by a polynucleotide, classified in class 530, subclass 300.
- IV. Claim 12, drawn to an antibody to a polypeptide, classified in class 530, subclass 388.1.
- V. Claim 13, drawn to antibody-based methods of screening, classified in class 435, subclass 7.1
- VI. Claim 14 (in part), drawn to peptide-based method of screening, classified in class 435, subclass 7.1
- VII. Claim 14 (in part), drawn to polynucleotide-based method of screening,

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classified in class 435, subclass 6.

- VIII. Claim 15, drawn to diagnostic kit comprising means for determining products of Groups I nor III.
- IX. Claim 16, drawn to use of antibody in cancer treatment.
- X. Claim 17 (in part) drawn to vaccine comprising polypeptide of Group I, classified in class 424, subclass 184.1.
- XI. Claims 17 (in part) drawn to vaccine comprising polynucleotide of Group II, classified in class 424, subclass 184.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and III are separate and distinct because the inventions are directed to different chemical types regarding the critical limitations therein. For Group III, the critical feature is a polypeptide whereas for Group I the critical feature is a polynucleotide. It is acknowledged that various processing steps may cause a polypeptide of group III to be directed as to its synthesis by a polynucleotide of Group I, however, the completely separate chemical types of the inventions of Groups I and III supports the undue search burden if both were examined together. Additionally, polypeptides have been most commonly, albeit not always, separately characterized

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and published in the Biochemical literature, thus significantly adding to the search burden if examiner together, as compared to being searched separately. Also, it is pointed out that processing that may connect two groups does not prevent them from being viewed as distinct, because enough processing can result in producing any composition from any other composition if the processing is not so limited to additions, subtractions, enzyme actions, etc.

Inventions III and IV are separate and distinct as the polypeptides of Invention III are structurally and biochemically different than the antibodies of Invention IV. While the antibodies may bind to the polypeptides of Invention III, the biochemical structures and activities of each Invention are quite different, requiring differing methods and areas of search, which would impose an undue burden upon the examiner.

Methods II, VII are alternative methods of use of polynucleotide of Group I.

Methods V and IX are alternative methods of use of antibodies of Group I.

The kit of Group VIII is unrelated to other Groups as it is not drawn to any specific structure (e.g., a particular polypeptide or polynucleotide structure).

Group II and X are drawn to patentably distinct products which require differing characteristics. The vaccine composition requires different host, not required for polypeptide of Group II, has different pharmaceutical effect, and has separate

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enablement requirement. In addition, the Groups are differently classified.

Group I and XI are drawn to patentably distinct products which require differing characteristics. The vaccine composition requires different host, not required for nucleic acid of Group I, has different pharmaceutical effect, and has separate enablement requirement. In addition, the Groups are differently classified.

Groups X and XI are drawn to patentably distinct products, as vaccine of Group XI comprises nucleic acid, whereas the vaccine of Group X comprises polypeptide.

***Sequence Election Requirement Applicable to Groups III-VIII***

In addition, each of the Group detailed above reads on a plurality of independent and/or patentably distinct sequences. Each peptide or nucleic acid sequence is independent and/or patentably distinct because they are unrelated compounds, there is no disclosed core structure required for a common utility, and because each of these compounds possess different structure and/or physico-chemical properties, and/or capable of separate manufacture and/or use. **For an elected Group the Applicants must further elect a single amino acid or nucleic acid sequence.**

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MPEP 803.04 states:

Nucleotide sequences encoding different proteins are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute independent and distinct inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 et seq.

Examination will be restricted only to a Group drawn to elected sequences.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and because of their recognized divergent subject matter, and the necessity for non-coextensive literature searches restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one

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claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Borin whose telephone number is (703) 305-4506. Dr. Borin can normally be reached between the hours of 8:30 A.M. to 5:00 P.M. EST Monday to Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Mr. Michael Woodward, can be reached at (703) 308-4028. The fax telephone number for this group is (703) 305-3014.

Any inquiry of a general nature or relating the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

MICHAEL BORIN, PH.D  
PRIMARY EXAMINER

January 22, 2004

mlb

